

REMARKS

Claims 1-19 and 21-29 are the only claims pending. Claims 16-19 and 21-29 are cancelled due to a restriction requirement.

Claims 1, 8, 11, 14 and 15 are currently amended.

Claims 7, 13 and 15 are withdrawn from consideration by the Examiner as being drawn to a non-elected invention. The Applicants request that claims 7, 13 and 15 be rejoined with the invention of Group I for examination. Claim 7 is one specific compound of component (a) which is generically described in claim 1. Claim 13 describes the generic Markush group for the triazine UV absorbers of component (c). A specific compound elected for prosecution of component (c) is the compound of formula (5e) of claim 14 which is a member of the triazine UV absorber Markush group listed in claim 13. The specific compound listed in claim 15 is a triazine UV absorber which is also a member of the triazine UV absorber Markush group listed in claim 13.

Claim 8 is currently amended for clarity.

The limitations of claims 9 and 10 are incorporated into claim 1. Accordingly, claims 9 and 10 are cancelled.

The limitations of claims 12 and 13 are incorporated into claim 1. Accordingly, claims 12 and 13 are cancelled.

Additionally, claim 1 is currently amended to incorporate weight ranges for components (a), (b) and (c). Support for these weight ranges is located in originally filed claim 25.

Claims 11, 14 and 15 are currently amended to correct dependency.

Claim 11 is currently amended to delete the term "%".

No new matter has been added.

Claims 1-8, 11, 14 and 15 are presented for reconsideration.

Claim Objections – Formal Reasons

Claim 11 is objected to because the term “%” should have been deleted. As suggested by the Examiner, claim 11 is currently amended to delete the term “%”.

Specification Objections – Formal Reasons

The specification is objected to because of the following informalities: the term “L*” is used on page 34, but no explanation of this term is provided.

The term “L*” refers to the L value which is part of the L, a, b color scale and is calculated using the CIE system from the reflectance values. This term is known in the literature and can be found in, for example, US 6,740,132 column 12; US 6,667,403 column 12; US 6,562,085 column 12; US 6,562,083 column 14; and US 6,544,305 column 9. Additionally, these color measurements are discussed further in Working Example 6 and Table 6.

As per the suggestion of the Examiner, the following amendments are made to the specification:

Page 40 second paragraph delete “Finsolv” and replace with “FINSOLV”;

Page 45 fourth paragraph delete “Carbopols” and replace with “CARBOPOLS”;

Page 45 fourth paragraph delete “Synthalens” and replace with “SYNTHALENS”;

Page 46 second paragraph delete “Polymer JR 400” and replace with “POLYMER JR 400”;

Page 46 second paragraph delete “Luviquat” and replace with “LUVIQUAT”;

Page 46 second paragraph delete “Lamequat” and replace with “LAMEQUAT”;

Page 46 second paragraph delete “Cartaretins” and replace with “CARTARETINS”;

Page 46 second paragraph delete “Merquat” and replace with “MERQUAT”;

Page 46 second paragraph delete "Jaguar" and replace with "JAGUAR";
Page 46 second paragraph delete "Mirapol" and replace with "MIRAPOL";
Page 47 fourth paragraph delete "Locron" and replace with "LOCRON";
Page 47 fourth paragraph delete "Hydagen" and replace with "HYDAGEN";and
Page 58 Example 6 delete "compositionw" and replace with "compositions".

Claim Rejections – 35 USC 103(a)

Claims 1-6, 8-12 and 14 are rejected under 35 USC 103(a) as being unpatentable over Hague (WO 2001/70189) in view of Sakoda et al. (WO 1998/17247) and Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291).

WO 2001/70189 discloses methods and compositions for lightening the skin color comprising an alpha- or beta-hydroxy substituted carboxylic acid, an antimicrobial agent, a sunscreen agent and a pharmaceutically acceptable carrier. Suitable sunscreen agents are listed on pages 9-12. WO 2001/70189 is totally silent with regard to the use of triazine UV absorbers in skin lightening methods or skin lightening compositions.

WO 1998/17247 discloses methods and compositions for lightening mammalian skin comprising kojic acid, salicylic acid, water and a water soluble glycol ether. Optional additional ingredients are listed on pages 4-7. Included in these optional ingredients are water-soluble ultraviolet and infrared screening and absorbing agents. WO 1998/17247 gives no guidance or motivation and is totally silent as to the use of triazine UV absorbers in skin lightening methods or skin lightening compositions.

Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291) discloses a study investigating the response of two sunscreen components in estrogen receptor and androgen receptor binding assays *in vitro*. Tinosorb M and Tinosorb S are also evaluated in immature rat uterotrophic assays using a subcutaneous route of administration. It is concluded from this study that neither of these two sunscreen components are likely to act as hormonal mimics in animals. Ashby et al. does not provide any guidance or motivation as to what compositions or methods to incorporate these sunscreen components into. Furthermore, Ashby et al. is totally silent with regard to what type of applications these sunscreen components are to be used in.

The instant amended claims provide a method for inhibiting melanogenesis and for lightening skin which comprises contacting said skin with a composition comprising a halogenated hydroxydiphenyl ether of component (a) and a skin lightening substance of component (b) and a triazine UV absorber of component (c). The surprising results obtained by the instant invention are demonstrated in the Working Examples.

References which merely indicate that isolated elements in the claims are known is not a sufficient basis for concluding that the combination of claimed elements would have been obvious. To properly combine two references to reach a conclusion of obviousness, there must be some teaching, suggestion or inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, which would have led one to combine the relevant teachings of the two references.

Without knowledge of the instant invention said invention is unobvious for a person skilled in the art because without teaching and motivation in the cited prior art or any other useful hints and without substantial testing no person skilled in the art could expect the advantageous properties of the instant invention.

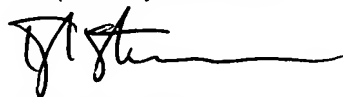
From the teachings of WO 2001/70189, WO 1998/17247 and Ashby et al (*Regul. Toxicol. Pharmacol.* **2001** 34(3), 287-291) either alone or in combination, a person of ordinary skill could not have predicted these surprising results and superior skin lightening properties of the instant invention.

These are surprising results and would not have been expected based on the prior art.

The Examiner is kindly requested to reconsider and to withdraw the present objections and rejections.

Applicants submit that the present claims are in condition for allowance and respectfully request that they be found allowable.

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